

REMARKS

Claims 1 and 2 have been canceled, and claim 3 has been amended so that it does not depend on a canceled claim.

Since it is believed that the above amendment places the application in condition for allowance, entry of the above amendment is respectfully requested.

Rejection over Ueno '523

On page 2 of the Office Action, in paragraph 3, claims 1-3 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ueno (5,786,523).

In response, Applicants note that claims 1 and 2 have been canceled, and claim 3 has been amended to depend from claim 4, which has not been included in this rejection. In this regard, Applicants note that the '523 patent is silent about using the naphthol compound of the present invention for manufacturing electrophotographic toner.

Thus, Applicants submit that the present invention is neither anticipated by nor obvious over Ueno '523, and withdrawal of this rejection is respectfully requested.

Rejection over Ueno '812

On page 2 of the Office Action, in paragraph 4, claims 1-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ueno (6,409,812).

In response, Applicants submit that the Examiner incorrectly found that '812 patent teaches naphthol derivatives suitable for use in toner applications. In this regard, Applicants note that claim 13 of the '812 patent recites a toner composition comprising an azo pigment, not a naphthol derivative. Applicants submit that the '812 patent is basically directed to an azo compound, and a naphthol derivative is recited only in Claim 11.

Applicants note that the naphthol derivative is a starting material for manufacturing the azo compounds, but Applicants submit that the properties of naphthol and azo compounds are very different. In particular, the azo compounds are used as pigments. As discussed in the '812 patent, the azo derivative provides a wide range of bright color from orange to purple (see column 2, lines 23-29, column 6, lines 53-55, and Examples 2-1 to 2-77 (with Table 6 et seq showing the color of obtained azo compounds)). The '812 patent also discloses a toner composition which comprises a charge control agent in addition to the azo pigment. However, the examples of "charge control agents" disclosed in '812 patent do not contain a naphthol compound (see col. 8, lines 30-48).

In contrast, the naphthol derivative of the present invention is white to light color, and therefore will not affect the color of the colorant contained in the toner such as an azo pigment (page 12, lines 13-17 and examples). In other words, the naphthol derivative of the invention is of no use as a pigment or colorant in a toner composition.

Thus, Applicants submit that one of ordinary skill in the art would not have been motivated to use the colorless naphthol compound recited in the instant claims for manufacturing toner based on the '812 patent disclosing to use the azo pigments as colorants of the toner.

Accordingly, Applicants submit that the present invention is neither anticipated by nor obvious over the '812 patent, and withdrawal of this rejection is respectfully requested.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

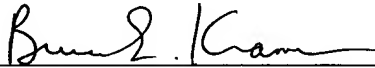
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